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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,846	12/21/2000	J. Francis Russel	50N3777.01	2168

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EXAMINER

BARQADLE, YASIN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,846

Applicant(s)

RUSSEL, J. FRANCIS

Examiner

Yasin M. Barqadle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

1. Applicant's arguments filed on June 28, 2005 have been fully considered but they are not persuasive.

- Claims 4, and 6-29 have been canceled.
- Claims 1-3, and 5 are presented for examination.

Response to Arguments

2. In response to applicant's argument in page 4, paragraph 2, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Allen did not preclude the utilizing of an of-the-shelf software program (packages) for manipulation and conversion purpose. On the contrary Allen suggested that "many of the compression, decompression and data manipulation

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facilities described herein could be performed through either software, hardware or a combination of both." Col. 16, lines 2-5. Further more, one ordinary skill in the art would be motivated to use such of-the-shelf software programs like PDF because they are easily accessible across multiple platforms (PC, MAC, UNIX, LINUX). PDF provides strong copyright protection, is web ready and looks exactly like the originals. PDF files are compact, cross-platform and can be viewed by anyone with an Acrobat Reader.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen US (5794217) in view of Kolling et al US (6385595).

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As per claim 1, Allen teaches a method for preparing graphical content associated with corresponding digital audio content, comprising (fig. 1 and abstract):

receiving said graphical content associated with said corresponding audio digital content from a digital database [col. 5, lines 26-45 and col. 9, lines 34-55]; and

preparing said graphical content for packaging with said corresponding digital audio content with a compact disk containing said corresponding digital audio content (col. 6, lines 38-55 and col.8, lines 1-55) by implementing at least one format conversion [col. 6, lines 38-55; col. 11, line 38-62 and col. 11, lines 38-62].

Although Allen shows substantial features of the claimed invention including reformatting graphic files into a printable format (col. 6, lines 38-55 and col. 11, line 38-62) and printing a graphic output and producing a duplicate of a title on a media useable by a consumer (col. 6, lines 38-55), he does not explicitly show a software program for manipulating and creating both postscript and PDF files.

Nonetheless, these applications are well known in the art and would have been an obvious modification of the system disclosed by Allen, as evidenced by Kolling et al USPN. (6385595).

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In analogous art, Kolling et al whose invention is about preparing electronic statement that includes audio, full motion video, graphics, images and custom enclosure, disclose a template authoring system that utilizes of-the-shelf software program (packages) for manipulating, converting and creating both postscript and PDF files [Col. 9, lines 53 to col. 10, line 25]. Giving the teaching of Kolling et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Allen by employing of-the-shelf software packages taught by Kolling et al for their ubiquitous use in desktop publishing and printable materials and for their support in creating, editing and converting file formats (i.e., converting Postscript to PDF [col. 10, line 1-25]).

Kolling teaches printing said (PDF) files [col. 19, lines 40-57].

As per claim 2, Allen teaches the method according to claim 1, wherein said receiving step comprises downloading said graphical content from said digital database [col. 5, lines 26-45 and col. 6, lines 38-55].

Kolling as modified teaches a first software program with a format compatible to graphical content [col. 10, lines 11-25].

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As per claim 3, Kolling et al teach the method according to claim 2, wherein the first software program includes Quark Xpress [col. 23, lines 10-25].

As per claim 5, Kolling et al teach the method according to claim 2, wherein the first software program includes Acrobat Distiller [col. 10, lines 11-16].

Conclusion

4. **ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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A handwritten signature in black ink, appearing to read 'Dung C. Dinh', with a stylized flourish extending to the right.

Dung C. Dinh
Primary Examiner